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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,332	01/26/2004	Takashi Ikeda	393032043200	9951
25224 7590 09/10/2007 MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			EXAMINER AUGUSTIN, EVENS J	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/765,332	Applicant(s) IKEDA ET AL.	
	Examiner Evans Augustin	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This is in response to an amendment filed on 18 June 2007. Claims 1, 5, 9, 13 and 19 have been amended. Claims 1-3, 5-7, 9-11 and 13-19 are pending.

Response to Arguments

2. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 18 June 2007, but has not found those arguments to be persuasive.

Argument 1: Prior Art does not teach "does not read the reproduction limiting information from the performance data when the identified usage right indicates the purchase;

A. **Response 1:** The prior art by Wiser differentiates between previewing and purchasing. The encrypted version of the song is a high fidelity audio image that is to be purchased. The un-encrypted versions of a song are either selected portions, or the entire song, but recorded with lesser quality, such as increased compression and/or lower sample rate. These un-encrypted lower quality 'clips' are available free for previewing by the consumer in order to decide whether or not to purchase the high fidelity version (col. 3, ll. 54-61). The preview enables the user to decide whether or not to purchase the entirety of the song for permanent storage on their hard disk and subsequent recording to a CD-R or other external device (col. 11, ll. 42-45). The previewing aspect also includes information such as duration of the clip or song, data size of the encoded audio to be delivered, starting and ending times of the clip, fade-in and fade-out durations, and bandwidth (col. 15, ll. 57-60)

Application stands finally rejected.

Claim Interpretation

3. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.

4. It should also be noted that, in the office action that:

- B. Passages in prior art references may be mere rephrasing/rewording of claimed limitations, but the implicit/explicit meaning of the references vis-à-vis the claimed limitation remains intact.
- C. Functional recitation(s) using the word “for” or other functional terms have been considered but given less patentable weight¹ because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

¹ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

- D. Word(s) that are separated by “/” are being examined as being synonymous or equivalent
- E. “Reproduction limiting information” is being interpreted as a preview /clip of content/song with starting and end time. The previewing aspect also includes information such as duration of the clip or song, data size of the encoded audio to be delivered, starting and ending times of the clip, fade-in and fade-out durations, and bandwidth (col. 15, ll. 57-60)
- F. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.
- G. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.
- H. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.

- I. The USPTO interprets common computer related words that are not lexicographically defined, in accordance to Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997². The USPTO also uses published patent applications and issued patents as well, for meanings of common computer related words that are not lexicographically defined.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

² Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" to define the term "flag." See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled 'New Terminology.'

6. Claims 1-7, 9-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiser et al. (U.S 6385596).

7. As per claims 1-7, 9-19, Wiser et al. disclose a computer system that provides a secure online music distribution system that provides consumers with flexibility and ease of use in the selection, previewing, downloading, and transporting of audio and other digital media over the Internet, and that provides for security of the media throughout the distribution system. The computer system comprises of the following:

- A. Client/server architecture with a clients computer system connected with a server online music distribution system that provides consumers with flexibility and ease of use in the selection, previewing, downloading, and transporting of audio and other digital media over the Internet, and that provides for security of the media throughout the distribution system (column 3, lines 5-20) – *Claims 1, 5, 19*
- B. The system allows a potential user to **preview a portion of a song** (column 7, lines 61-62, column 11, 39-44), to be played or stored on a client system -*Claims 1, 5, 19*
- C. The system allows a potential user to **preview a portion of a song** (column 7, lines 61-62, column 11, 39-44), to be played or stored on a client system. The information about the duration of a song to be previewed tells a user that a 30 second preview of a 5-minute song will be reproduced or played for 30 seconds. The remaining 4 minutes and 30 seconds of the songs will not be heard or reproduced. -*Claims 1, 5, 19*

- D. The media player is the mechanism by which the consumer plays back purchased or previewed audio data, and by which the consumer digitally records purchased media data files to a further external memory, such as a CD-Recordable, CD-RW, Mini-Disc, flash memory, or the like. The media player provides user interface controls for viewing lists of purchased and stored media data file, viewing cover and promotional art and graphics, reading lyrics and other liner information, organizing play lists and tracklists, and other music database management features (column 10, lines 1-16) - *Claims 5, 19*
- E. System limiting the reproduction/copies of content (column 3, lines 33-50, column 4, lines 42-50, column 7, lines 27-37) – *Claims 1, 5, 9*
- F. The system allows a potential user to preview a portion of a song (column 7, lines 61-62, column 11, 39-44), to be played or stored on a client system. The client system can be any number of client devices (column 5, line 48) with media player for playback and a browser (column 5, line 67) running, for example, on Apple or Microsoft operating systems (column 6, lines 8-14). The invention contains a server apparatus that store information regarding the song (for example: song title, artist, preview, and purchase) (figure 8, column 14, lines 43-45). The prior art also stores information such duration of the preview or song, song/preview size, starting and ending times of the song/preview, fade-in and fade-out durations (usage right of content), all of which is transferred to the client system (column 15, lines 56-61) - *Claims 1, 5, 9, 16-19*

- G. The same interface allows a user to preview and purchase the same content (figures 8 and 14) to be delivered and stored on the client device (column 11, 39-44) - *Claims 1, 5, 9, 16-19*
- H. The system enables prospective buyers of an audio content to clip portions of content, with a defined start and stop time for sampling/reproduction (column 7, lines 50-55) – *Claims 1, 2, 6, 10, 19*
- I. Generation usage rights associated with the content (column 10, lines 45-47, column 11, lines 1-6) – *Claims 1, 5, 9*
- J. Allowing users to store content in their hard disks (column 11, lines 42-45) - *Claims 1, 5*
- K. The media player sets up communication channel with the specified delivery server and passes in the voucher ID and the media ID and bandwidth requirement. The media player also provides port information identifying which ports it is to receive the streamed audio data from the delivery serve (column 15, lines 33-43) - *Claims 3, 7, 11*
- L. The audio content contains a mechanism that allow is to provide different functions such as quality levels on playback, using different sampling rates and compression levels. The mechanism also includes optional functions such as restrictions on playback and record to external devices or files (column 7, lines 4-16) – *Claims 4, 8, 12*
- M. An online music distribution system in accordance with the present invention includes a variety of cooperative components that communicate over a public

network, preferably the Internet. These components include a content manager, one or more delivery servers, a media data file system and media information database. HTTP servers facilitate Internet communications by the system. Any number of individual purchasers use client computer systems with Web browsers and media players (column 3, lines 9-19) – *Claim 13*

- N. Server is responsible for receiving requests from a media player to preview or purchase a media data file containing audio data (column 9, lines 56-58) - *Claim 13*
- O. Server transmitting the requested media file to the user (column 9, lines 60-67) - *Claim 13*
- P. The media files transmitted the user contains descriptive text, such as title, artist, lyrics, and liner notes, promotional art image data, and cover art image data (column 6, lines 59-62), and also contains mechanism to ensure usage rights are executed (column 7, lines 4-16) – *Claim 13*
- Q. Once the audio is has been purchased, the server gives the user the appropriate licensing and updated its records accordingly (column 19, lines 11-49) - *Claim 14*
- R. The system enables prospective buyers of an audio content to clip portions of content, with a defined start and stop time for sampling/reproduction (column 7, lines 50-55), The media player sets up communication channel with the specified delivery server and passes in the voucher ID and the media ID and bandwidth requirement. The media player also provides port information identifying which ports it is to receive the streamed audio data from the delivery serve (column 15,

lines 33-43). The audio content contains a mechanism that allow is to provide different functions such as quality levels on playback, using different sampling rates and compression levels. The mechanism also includes optional functions such as restrictions on playback and record to external devices or files (column 7, lines 4-16) – *Claim 15*

Conclusion

8. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/
Evens J. Augustin
September 3, 2007
Art Unit 3621

 9/4/07
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